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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

SWARTZ, JAMIE H

ART UNIT	PAPER NUMBER
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3694

DATE MAILED: 12/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/974,823

Applicant(s)

SHIMADA ET AL.

Examiner

Jamie H. Swartz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 October 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 7-15 is/are pending in the application.
- 4a) Of the above claim(s) 3-6 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 7-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 October 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Claims 3-6 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on October 23, 2006. Accordingly claims 1-2 and 7-15 have been examined.

Drawings

2. The drawings are objected to because Fig. 8 appears to be incorrect based the description in the specification. Based on the specification follow level 5 in the name column should be "all indicated," currently name is "not indicated." Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement-drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If

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the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-2, 7-10, 13 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claim 1 recites the limitation "results of consultation received" line 17. "Results of consultation" is vague and renders the claim indefinite because it is unclear what kind of consultation is being referred to, who or what is doing the consulting, and what kinds of results are being presented. Without knowing the type of consultation is occurring the results are also unknown.

6. Claim 10 recites the limitation "said business management support service" line 5. The phrase "said business management support service" renders the claim indefinite because the claim includes elements not related to claim 1, thereby rendering the scope of the claim unascertainable.

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7. Claim 10 recites the limitation "various settlements" lines 7-8. The phrase "various settlements" is vague and renders the claim indefinite because the term "settlements" is too broad since it is recited without any context and any degree of specificity that would allow the examiner to perform claim analysis within the specified field of endeavor.

8. Claims 13 and 15 recite the limitation "unit" lines 2, 5, and 10 and pg. 45, lines 14 and 17. "Unit" when referred to in the claim is not functionally connected to any element(s) of the system. Upon examination of the specification "unit" appears to refer to people instead of a functional device. An apparatus cannot comprise humans as elements.

9. Claims 2, 7, and 8 are dependent on claim 1 and inherit the rejection under 35 U.S.C. 112.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

11. Claims 1, 2, 9, and 11-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Broadbent et al (US 6904412 B1) (referred to as Broadbent).

12. Referring to claims 1, 9, and 11-15, Broadbent teaches a business management support method using computers of a service provider, a service beneficiary, a service intermediary, and an intellectual service cooperator attached to a network comprising an *information-collecting step, which includes collecting enterprise information from said computer of said service beneficiary* (col. 9, lines 8-20). The borrower uses a computer to input their personal data (col. 9, lines 34-38). Broadbent teaches a *requesting step which includes providing said collected enterprise information to said computer of said intellectual service cooperator to make a request for consultation* (col. 9, lines 19-30 and col. 14, lines 18-26). Broadbent teaches an *information providing step which includes posting said computer of said service intermediary on the results of consultation received from said computer of said intellectual service cooperator, and adding service intermediary transaction information to said results to create support information for*

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provision to said service beneficiary (col. 12, lines 24-34 and col. 14, lines 18-26).

Broadbent teaches how each party involved uses a computer (col. 14, lines 18-52)

13. Referring to claim 2, Broadbent teaches when a *service intermediary is a bank which has dealings with said service beneficiary* (col. 12, lines 24-34).

14. Referring to claim 9, while the specific names of the types of parties that would serve the intellectual service cooperator (i.e., an auditing corporation, a think tank, a securities firm, and a capital gain company) are not expressly disclosed by Broadbent, the specific names of the types of parties are mere labels. The particular names of the parties do not change the requesting step or the information provided steps in claim 1 (from which claim 9 depends). As stated in claim 9, *an auditing corporation, a think tank, a securities firm and a capital gain company* are mere labels corresponding to the type of person performing the invention and such labels do not affect any recited structure or method. Analogous to the situation in *Ex parte Pfeiffer*, 135 USPQ 31 (BdPatApp&Int 1961) where structural limitations were not entitled to weight in method claims, the recited names of parties limitation therein must affect the method in a manipulative sense. In claim 9, since the recited names of parties does not affect the method in a manipulative sense, these specific names of parties do not patentably distinguish claim 9 over the prior art.

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15. Referring to claim 11, Broadbent additionally discloses a business management support program *run by a computer* (col. 14, lines 18-26) *of a service provider, which is connected, via a network* (col. 14, lines 27-46). Further details of claim analysis is provided under the claim 1 rejection, especially as they apply to the commonly recited claim limitations.

16. Referring to claim 12, Broadbent additionally teaches a *computer readable record medium having thereon recorded a business management support program to be run by a computer* (col. 7, lines 24-33). Further details of claim analysis is provided under the claim 1 rejection, especially as they apply to the commonly recited claim limitations.

17. Referring to claim 13, Broadbent additionally teaches a computer that acts as an *information collecting unit, a requesting unit, and an information providing unit* (col. 6 line 15 – col. 7 line 44).

18. Referring to claim 14, Broadbent additionally teaches an *information-providing step which includes providing enterprise information in response to a request from said computer of said service provider* (col. 9, lines 8-30). Broadbent teaches an *information-accepting step which includes accepting the results of consultation received from said computer of said intellectual service cooperator* (col. 9, lines 8-30).

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19. Referring to claim 15, Broadbent additionally teaches a computer that functions *as an information-providing unit which includes providing enterprise information in response to a request from said computer of said service provider* (col. 7, lines 4-44). Broadbent teaches a computer that functions *as an information-accepting unit which accepts the results of consultation received from said computer of said intellectual service cooperator* (col. 6, line 15 – col. 7, line 44).

Claim Rejections - 35 USC § 103

20. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

21. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Broadbent et al (US 6904412 B1), as applied to claim 1 above, in view of O'Flaherty et al (US 6253203 B1).

22. Regarding claim 7, Broadbent shows information collecting, requesting, consulting, and information providing steps but does not show predefined follow levels. O'Flaherty, however, shows a database *that depending on predefined follow levels, masking is effected in sequence on enterprise information collected in said information collecting step, enterprise information provided to said computer of said intellectual*

service cooperator in said requesting step, and the results of consultation on which said computer of said service beneficiary is posted in said information providing step. (col. 7, line 1 – col. 10, line 55) Also see figures 2A-3C. O'Flaherty specifically discusses banking, mortgages (col. 1, line 57-67), financial information (col. 10, line 2-6), and the use of databases (col. 2, lines 53-56). O'Flaherty states his invention serves to prevent abuse associated with accessing personal customer information (col. 2, lines 30-40). Broadbent's invention is related to mortgage processing using databases. Similarly, O'Flaherty's invention is related to database security and references mortgages. It would have been obvious to a person of ordinary skill in the art at the time the invention to modify Broadbent to include the data column control for extra security with the information and for consumer privacy. This allows a company to avoid passing sensitive information to people without approved access while allowing maximum use of the system without a security leak/risk as suggested by O'Flaherty.

23. Regarding claim 8, Broadbent shows information collecting, requesting, consulting, and information providing steps but does not show various follow levels or masking. O'Flaherty, however, shows different dataviews which are provide different levels of visibility into the data in the customer table using masking. The privileged view (col. 8, lines 35-50) is *when said follow level is a maximum level, said enterprise information and said results of consultation are completely indicated without masking, and wherein the standard view* (col. 8, lines 5-34) is *when said follow level is a minimum level, masking is made on attribute information other than requisite items in said*

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enterprise information and said results of consultation, and wherein the anonymizing view (col. 9, lines 4-12) is when said follow level is a level lying between said maximum level and said minimum level, said attribute information is indicated partially or in a simplified manner. Broadbent's invention uses databases while O'Flaherty invention demonstrates a more sophisticated level of database security. Database security is more critical then ever now as networks have become more open. Database security exists as systems, processes, and procedures that protect a database from authorized misuse, malicious attacks or inadvertent mistakes made by authorized individuals or processes. Increased database security allows a company to avoid passing sensitive information to people without approved access while allowing maximum use of the system without a security leak/risk. It would have been obvious to a person of ordinary skill in the art at the time the invention to adapt Broadbent to have a maximum and minimum level of security on the information in a database to protect their customer's information (as taught by O'Flaherty), especially since Broadbent handles very confidential finance data of their customers.

24. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Broadbent et al (US 6904412 B1), as applied to claim 1 above.

25. Regarding claim 10, Broadbent shows information collecting, requesting, consulting, and information providing steps but does not show business management support service includes management diagnosis, support of going public business,

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support of publicity work for investors and support of various settlements. Official notice is taken that the practices of management diagnosis, support of going public business, publicity work, and various settlements were each individually old and well-known in the management/ public relations field at the time of the invention. These practices help to improve a business' public image, which is important in attracting and retaining customers. Since Broadbent relies on keeping its customers content for the continued success of its loan processing services, the Examiner submits that it would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Broadbent's business management support method to include management diagnosis, support of going public business, support of publicity work for investors and support of various settlements in order to more successfully build, manage and sustain a positive image, thereby making Broadbent's services more appealing to future customers.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamie H. Swartz whose telephone number is (571) 272-7363. The examiner can normally be reached on 8:00am-4:30pm Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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December 5, 2006

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